REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 31, 32, 39, 40, 47 and 48 have been cancelled. Claims 1, 8, 15, 25-30, 33-38 and 41-46 are pending.

Rejection of the claims

The most recent Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,992,687 ("Baird").

Claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and
> in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

Claim 8 recites:

8. A system, comprising:
a computing device for:
storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and
in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computing device to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

Claim 15 recites:

15. A computer program product stored on a tangible computer-readable medium, comprising:
a computer program processable by a computer system for causing the computer system to:
store an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and
in response to content of a first portion of the likeness, form a hyperlink reference and embed the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

In MPEP § 2131, the PTO provides that:

> *"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain a rejection of claim 1, Baird must contain all of the above-recited elements in claim 1. However, Baird fails to teach the combination of elements in claim 1. In fact, Baird teaches away from such a combination.

For example, claim 1 recites (in part), "***in response to content of a first portion of the likeness, forming a hyperlink reference*** and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and ***wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location***" (emphasis added).

With respect to the "***content of a first portion of the likeness***" in Applicant's claim 1, the Office Action cites Baird's visual indicators 301, 305, 401 and 403, which comprise information (e.g., respective page numbers) that identify parts (of a document) that are marked by the visual indicators 301, 305, 401 and 403.

With respect to the "***forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness***" in Applicant's claim 1, the Office Action cites Baird's col. 7, lines 13-40, and col. 7, line 60-col. 8 line 6, which describe creation of a bookmark object that is linked (e.g., hyperlinked) to a particular part (e.g., page) of a document.

Baird explicitly teaches that its bookmark object is generated "substantially contemporaneously" with rendering its visual indicator. For example, at col. 8, lines 47-48, Baird states, "FIG. 7 is a flow chart illustrating the operation of bookmarks in accordance with the present invention." At col. 8, lines 56-60, Baird states, "In response to the selection signal, at step 702, a visual indicator is rendered on the display that is currently displaying

the document being marked. At step 703 and substantially contemporaneously with step 702, a bookmark object is also generated" (emphasis added).

Consequently, Baird's bookmark object (step 703) is ***not*** generated ***in response to*** its visual indicator (step 702). Instead, Baird explicitly teaches that both steps 702 and 703 occur "substantially contemporaneously" in response to a user-generated selection signal. For example, at col. 5, lines 8-15, Baird states, "As known in the art, by 'clicking' the mouse while the cursor 211 is pointing to the point 213, a selection signal is generated indicating that the user has selected the point 213. Alternatively, where a touch screen is used, a user need not control a position of a cursor, but may instead simply 'tap' the screen at the selected point 213 in order to generate the selection signal. Regardless of the method used, the selection signal generated in this manner can be used to create a bookmark as described in greater detail below." Further, at col. 9, lines 6-7, Baird states, "As described above, the processing of steps 702 and 703 occurs automatically in response to the selection signal." At col. 9, lines 13-17, Baird states, "In this case, before steps 702 and 703 are carried out, the user is first presented with a choice of which action they would like to perform. Steps 702 and 703 would then be executed after the user has elected to create a bookmark based on his selection signal."

Therefore, Baird explicitly teaches that both steps 702 (visual indicator) and 703 (bookmark object) occur "substantially contemporaneously" in response to a user-generated selection signal. Consequently, Baird's bookmark object (step 703) is ***not*** generated ***in response to*** its visual indicator (step 702). Thus, even if the Office Action reads "visual indicator" as being "***content of a first portion of the likeness***," and reads "generating a bookmark object" as being "***forming a hyperlink reference***," Baird would explicitly teach away from Applicant's claim 1, which recites (in part), "***in response to content of a first portion of the likeness, forming a hyperlink reference***."

Accordingly, Baird fails to support a rejection of claim 1 under 35 U.S.C. § 102(e). In relation to claims 8 and 15, Baird is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not

produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Baird is defective in establishing a prima facie case of obviousness. As between Baird and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 1. In fact, Baird teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to claims 8 and 15, Baird is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of claims 1, 8 and 15 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 8 and 15.

Dependent claims 25-30 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 33-38 depend from and further limit claim 8 and therefore are allowable.

Dependent claims 41-46 depend from and further limit claim 15 and therefore are allowable.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

An early formal notice of allowance of claims 1, 8, 15, 25-30, 33-38 and 41-46 is requested.

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Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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